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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/538,663

FEB 21 2008

Filing Date: March 30, 2000

GROUP 3600

Appellant(s): JAKOBSSON ET AL.

Joseph B. Ryan
Reg. No. 37,922
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 November 2007 appealing from the Office action mailed 06 July 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

Regarding dependent claim 2, Appellant argues that the Official Notice taken by the Examiner is not proper and has challenged the Official Notice. The Examiner has thus provided a piece of prior art in support of the Official Notice. Therefore claim 2 stands rejected under 35 U.S.C. § 103(a) over Greenstein in view of Official Notice (as evidenced by Cockrill et al. U.S. 6,473,740) as discussed below in the Arguments section. Claim 3 is dependent upon claim 2 and is thus rejected under the same grounds. Claim 11 is substantially similar to claim 3.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|---------|
| 6,266,692 | GREENSTEIN | 7-2001 |
| 6,546,416 | KIRSCH | 8-2003 |
| 6,473,740 | COCKRILL ET AL | 10-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

1. The following communication is in response to Applicant's appeal brief filed 29 September 2006.

Status of Claims

2. Claims 1-6, 8-13 and 15-20 are currently pending.

Response to Arguments

3. Applicant's arguments with respect to the rejection of claims 1-6, 8-13 and 15-20 have been fully considered and are persuasive. However upon further examination a new grounds of rejection has been made as set forth below. Therefore, claims 1-6, 8-13 and 15-20 stand rejected.

Claim Objections

4. Claims 18 and 20 are objected to because of the following informalities: Regarding claim 18, line 2, the word “send” should be changed to “sender.” Claim 20, line 2, the word “send” should be changed to “sender.” Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 10 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenstein U.S. Patent 6,266,692.

Regarding claims 1 and 10, Greenstein discloses a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising:

determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 3, lines 38-51; Examiner notes that the passcode is analogous to a message authentication code; Figure 3); filtering out at a gateway of the communication system email directed to the particular receiver that does not comprise valid MAC information (column 3, lines 53-67; Examiner notes that the message is routed to a holding tank when there is no passcode and emails not accepted are rejected and the unwanted email is purged); and providing the particular receiver with email directed to the particular receiver that comprises valid MAC information (column 3, line 38-51; Examiner notes that the when the passcodes match, the user may then retrieve the email from the database via the email client).

Claims 17-20, further comprising determining if a particular sender is a registered sender of email to the particular receiver, wherein the particular sender becomes a registered sender by satisfying a requirement (column 2, lines 15-20; Examiner notes that all senders must be pre-approved and that individuals have unique passcodes; column 2, lines 59-64; Examiner notes that senders of the email who are not pre-approved can request approval).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein U.S. Patent 6,266,692 in view of Official Notice.

Claim 2, Greenstein teaches establishing an address related to an address associated with the particular receiver which will inform the particular sender that the particular receiver desires that the particular sender be able to send email to the particular receiver; and establishing by the particular receiver key which is forwarded to the particular sender by the particular receiver to inform the sender that the sender is authorized to send email to the receiver and is now a registered sender and for use by the sender whenever the sender wishes to send email to the receiver (column 3, lines 38-67; Examiner notes that the passcode is part of the address for sending the email; Figure 3). Greenstein fails to teach establishing a cookie which indicates to the particular receiver whether the particular sender has satisfied the requirement to allow the particular sender to become a registered sender. Official Notice is taken that cookies are old and well known in the computer arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Greenstein to include cookies because it allows for faster authentication of emails when communicating between computers.

Claims 3 and 11, Greenstein teaches generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the sender and receiver (column 2, lines 25-42).

9. Claims 4-6, 8, 9, 12, 13, 15 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein U.S. Patent 6,266,692 in view of Official Notice in further view of Kirsch U.S. Patent 6,546,416.

Claims 4-6, 8, 9, 12, 13, 15 and 16, Greenstein teaches a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising: determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 3, lines 38-51; Examiner notes that the passcode is analogous to a message authentication code; Figure 3). Greenstein fails to teach establishing an address comprises sending email from the particular receiver to the particular sender using public key encryption and determining whether the message has valid MAC information. Kirsch teaches a method and system for selectively blocking delivery of bulk electronic mail utilizing public key encryption as well as other encoding and encrypting algorithms (column 6, lines 51 thru column 7, line 12). It would have been obvious to one of ordinary skill in the art to modify the teachings of Greenstein in view of Official Notice with the public key encryption teachings of Kirsch because it allows for authenticating emails effectively when filtering emails with the motivation of removing unwanted emails.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 1, 10 and 17-20 under 35 U.S.C. § 102(e) over Greenstein.

10. Regarding independent claims 1 and 10, Appellant argues that the cited prior art fails to anticipate claims 1 and 10 because it fails to teach MAC information.

In Response: The Examiner respectfully disagrees with the Appellant. Appellant has defined MAC information in the specification broadly. The specification states that "When a sender appears on the list, a message authentication code (MAC) appended to the sender's M message will allow the message M to be received by the receiver 40. This can be thought of as a secret password specific to the sender, receiver and the sent email, and which only a sender who is registered can generate." The Examiner asserts that the passcode teachings of Greenstein conform to the definition provided in Appellant's specification.

Greenstein teaches email with passcodes for the purpose of using the passcode to block unwanted email, i.e. SPAM (column 3, lines 30-37). Greenstein teaches that the passcode is an individual code assigned to each sender (column 2, lines 43-46). The passcode is appended to the email in the header (column 2, lines 29-34). The incoming email passcode is checked against the receiver's passcode to determine if the passcode is a match for the email (column 3, lines 45-51). Greenstein also teaches maintaining a list of approved senders (column 4, lines 33-37). Therefore the teachings of Greenstein conform to the definition of a MAC as given in Appellant's specification as a secret password specific to the sender, receiver and the sent email, and which only a sender who is registered can generate.

Appellant further argues that the MAC is specific to the message whereas Greenstein teaches that the passcode is used for all messages by a particular sender. The argument is not persuasive because Greenstein teaches that the passcode is attached to a specific email and thus

is specific to the email (column 2, lines 29-34). As noted, above, the teachings of Greenstein conform to the broad definition in Appellant's specification.

Furthermore, the Examiner points our that Appellant is interpreting claims 1 and 10 narrowly and not given them their broadest reasonable interpretation. Regarding claims 1 and 10, all that is required by the claims is the determining, filtering and providing steps is "MAC information." Therefore, claims 1 and 10 do not even require a MAC, but instead just require at least some kind of "information" associated with a MAC. Items such as the sender name, email address, time-stamp, recipient name, recipient email address are types of "information" used in the MAC. Greenstein teaches including attaching such information to the email (column 4, lines 27-43). Therefore, given its broadest reasonable interpretation, "MAC information" is anticipated by Greenstein.

For these reasons, Appellant's arguments regarding claims 1 and 10 are not persuasive and thus stand rejected.

11. Regarding independent claims 17 and 19, Appellant argues that the cited prior art fails to teach that a sender becomes a registered sender by satisfying a requirement.

In Response: The Examiner respectfully disagrees with the Appellant. Greenstein teaches that all senders must be pre-approved before they can send an email to the recipient (column 2, lines 15-20). As noted above, Greenstein also teaches maintaining a list of approved senders (column 4, lines 33-37). The user provides a passcode to all welcome email participants and maintains a list of valid senders (column 2, lines 25-30). Greenstein alternately teaches that the sender can request a passcode (column 2, lines 59-63). Because Appellant merely provides

the broad language of satisfying a requirement, the teachings of Greenstein are sufficient. Greenstein teaches satisfying requirements because the sender must be welcomed, valid or submit a request. All these limitations satisfy a requirement to become pre-approved to send emails to the recipient.

For these reasons, Appellant's arguments regarding claims 17 and 19 are not persuasive and thus stand rejected.

12. Regarding independent claims 18 and 20, Appellant argues that the cited prior art fails to teach registering a sender when the particular sender is determined not to be a registered sender of email to the particular receiver.

In Response: The Examiner respectfully disagrees with the Appellant. Greenstein teaches that all senders must be pre-approved before they can send an email to the recipient (column 2, lines 15-20). As noted above, Greenstein also teaches maintaining a list of approved senders (column 4, lines 33-37). The user provides a passcode to all welcome email participants and maintains a list of valid senders (column 2, lines 25-30). Greenstein alternately teaches that the sender can request a passcode (column 2, lines 59-63). Thus, the unregistered sender becomes registered when a passcode is received. Furthermore, Greenstein teaches temporarily holding emails by senders who do not specify a passcode (i.e. not registered) and later decided to accept the email (column 3, lines 52-67; Examiner notes this to be registering the sender when the email is approved).

For these reasons, Appellant's arguments regarding claims 18 and 20 are not persuasive and thus stand rejected.

B. Rejection of claims 2, 3 and 11 under 35 U.S.C. § 103(a) over Greenstein in view of Official Notice (as evidenced by Cockrill et al. U.S. 6,473,740).

13. Regarding dependent claim 2, Appellant argues that the Official Notice taken by the Examiner is not proper and has challenged the Official Notice.

In Response: The Examiner respectfully disagrees with the Appellant. As noted above, Greenstein teaches satisfying a requirement to become a particular sender. As noted in the rejection, Greenstein fails to teach indicating the satisfying of becoming a particular sender using a cookie. Official Notice was taken that cookies are old and well known in the computer arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Greenstein to include cookies because it allows for faster authentication of emails when communicating between computers.

Cockrill teaches a system and method for facilitating transactions in a network between customers and merchants (column 6, line 65 thru column 7, line 21). Cockrill further teaches that the network reads a customer cookie stored on the customer's computer for the member identifier (column 10, line 66 thru column 11, line 1). In one embodiment the identifier is an email address or other information specific to the domain of the user (column 11, lines 1-12). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Appellant's application to modify the teachings of Greenstein to include cookies to show that a

user is a registered user (i.e. valid domain/valid passcode) because it allows senders to have their passcode identified via the cookie and thus not have to enter it every time and thus speed up the process of sending emails from registered pre-approved senders.

For these reasons, Appellant's arguments regarding claim 2 are not persuasive and thus stand rejected.

14. Regarding dependent claims 3 and 11, Appellant argues that the prior art fails to teach teaches generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the sender and receiver.

In Response: The Examiner respectfully disagrees with the Appellant. Greenstein teaches that the passcode can be an ASCII character stream, or randomly generated binary "key" to establish a passcode (column 2, lines 29-31). This established passcode is an address associated with a particular receiver letting the sender know that the receiver desired that the sender be able to send emails to the recipient consistent with claim 2.

For these reasons, Appellant's arguments regarding claim 3 and 11 are not persuasive and thus stand rejected.

C. Rejection of claims 4-6, 8, 9, 12, 13, 15 and 16 under 35 U.S.C. § 103(a) over Greenstein in view of Official Notice (as evidenced by Cockrill et al. U.S. 6,473,740) in further view of Kirsch.

15. Regarding dependent claims 4-6, 8, 9, 12, 13, 15 and 16, Appellant argues that there is insufficient motivation to combine the teachings of Greenstein with the teachings of Kirsch.

In Response: The Examiner respectfully disagrees with the Appellant. Greenstein teaches a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising: determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 3, lines 38-51; Examiner notes that the passcode is analogous to a message authentication code; Figure 3). Greenstein fails to teach establishing an address comprises sending email from the particular receiver to the particular sender using public key encryption and determining whether the message has valid MAC information. Kirsch teaches a method and system for selectively blocking delivery of bulk electronic mail utilizing public key encryption as well as other encoding and encrypting algorithms (column 6, lines 51 thru column 7, line 12). It would have been obvious to one of ordinary skill in the art to modify the teachings of Greenstein in view of Official Notice with the public key encryption teachings of Kirsch because it allows for authenticating emails effectively using information transmitted along with the email when filtering emails with the motivation of removing unwanted emails, fraudulent emails or SPAM not wanted by the recipient.

Regarding claim 12, the encrypted key taught by Kirsch qualifies as an encrypted address as it is used when authenticating email from the sender to the recipient.

For these reasons, Appellant's arguments regarding claims 4-6, 8, 9, 12, 13, 15 and 16 are not persuasive and thus stand rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stefanos Karmis/

Art Unit 3693



18 February 2008

Conferees:

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Art Unit 3691